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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COBY, FRANTZ

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/749,257

Applicant(s)
Hsiao et al.

Examiner
Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 27, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above, claim(s) NONE is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☒ Claim(s) NONE is/are objected to.
- 8) ☒ Claims NONE are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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This is in response to application filed on December 27, 2000 in which claims 1-33 are presented for examination.

Information Disclosure Statement

1. The information disclosure statement filed on March 04, 2002 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered as to the merits.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vellandi U.S. Patent no. 6,385,614.

As per claim 1, Vellandi discloses the invention including “a method for controlling online access to reference materials” by providing a shared electronic book which multiple users each have the right to access the book but only one of the users is allowed to actually access the book at a given point in time (See Vellandi Abstract). In particular, Vellandi discloses the claimed limitations “receiving an online request for a reference material” as a subscriber using the subscriber computer 14 to communicate a request (See Vellandi Col. 6, lines 18-36). Also, Vellandi discloses the claimed feature “providing access to the copy of the requested material if the requested reference material is available” as a book not presently allocated to another subscriber where the server 12 conveys a message to the subscriber computer 14 via the Internet system 16 that the subscriber has been granted exclusive access to the book (See Vellandi Col. 6, lines 33-43).

It is noted that although Vellandi specifically detailed the aspect of providing access to a book only if the book is available (not presently allocated to another subscriber) and denying access to a subscriber when the server does not receive a request with the noted cookie form the subscriber within a predetermined period of time, Vellandi did not specifically recite the claimed limitation of “temporarily denying access to the requested reference material if the requested reference material is not available” as recited in the instant claim 1. However, one of ordinary

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skill in the art at the time of the invention would have found it obvious that the aspect of “temporarily denying access to the requested reference material if the requested reference material is not available” would have occurred in the system of Vellandi whenever a book is presently allocated to another subscriber. The motivation being to have the owner of the electronic book to control access of the book more efficiently.

As per claim 2, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature “transmitting the copy of the requested reference material as a digital electronic file” by providing individuals access to an electronic book (col. 1, lines 46-47) where a copy of the electronic book is transmitted to the subscriber’s computer 14 when the electronic book is available.

As per claims 3-4, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses “a client side management programmed to provide an indication when the transmitted copy of the requested reference material has been replaced” through a browser program on the subscriber computers (Figure 1, component 14)

Although Vellandi discloses transmission of a book from the server to a user; It is noted that Vellandi did not specifically describe the aspect of “transmitting the copy of the requested

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material as HTML". However, Vellandi discloses mechanism to communicate electronic book through the World Wide Web. One of ordinary skill in the art at the time of the invention would have found it obvious to have the electronic book of Vellandi being communicate as HTML since the layout language for the World Wide Web or Web documents is Hypertext Markup Language and web documents are stored in HTML format in association with server software or remote software.

As per claim 5, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature "receiving an indication when access to the copy of the requested material is terminated" by permitting termination of a subscriber's access to a book upon expiration of the predetermined period (See Vellandi Col. 6, line 59-col.7, line 2).

As per claim 6, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "passing a token if a copy of the requested material is available" as a subscriber that uses the subscriber's computer 14 to communicate a request which includes a cookie to the server for access to a particular shared book (See Vellandi Col. 6, lines 33-36); and "receiving an indication in the form of a return of the token when access to the copy of the requested material is terminated" by providing mechanism for allowing a cookie to be returned

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before the predetermined period of time to access the book is about to be terminated so that the subscriber can then renew his/her access to the book (See Vellandi Col. 2, lines 29-63; col. 1, lines 51-60).

As per claims 7-8, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses "monitoring a client side browser to determine the client side browser has been for a prescribed period of time and to determine when an image of the requested reference materials has been replaced" by providing users access to the share electronic book for a predetermined period of time in which the client's browser is monitored (See Vellandi Col. 2, line 29-col. 3, line 18).

As per claim 9, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "Comparing a number of copies of the requested reference materials to which access is currently being provided with a maximum number of copies of the requested reference materials for which access can contractually be provided" by providing a counter which when equal to 1 determines whether a book is available to be transmitted to a subscriber through a process that compares a number of copies of the requested book to which

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access is currently being provided with a maximum number of copies of books (See Fig. 6; Col. 9, lines 10-29).

As per claim 10, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "determining if a server has possession of a token corresponding to the requested reference materials" as a cookie that is transmitted to the user from the server when a username and password is valid (col. 6, lines 27-33).

As per claim 11, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed features of --providing view access or denying view access to the requested reference material-- by providing mechanism for allowing a subscriber to view a selected book (See Vellandi Fig. 2B; Col. 6, lines 11-17; col. 5, lines 45-48).

As per claim 12, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "receiving an indication from a client side agent in the form of a return of a token when the copy of the requested material has been replaced in a client side browser" by providing mechanism for allowing a cookie to be returned before the predetermined

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period of time to access the book is about to be terminated so that the subscriber can then renew his/her access to the book or for the cookie to be transmitted to another user who wants to access the electronic book (See Vellandi Col. 2, lines 29-63; col. 1, lines 51-60). Notice that the subscriber computers 14 each include a web browser (See Vellandi Col. 5, lines 44-47).

As per claim 13, most of the limitations of this claim have been noted in the rejection of claim 11. Applicant's attention is directed to the rejection of claim 11 above. In addition, Vellandi discloses "transmitting a client side agent from a server" as transmitting a cookie to the requested subscriber and "receiving an indication from the client side agent when the copy of the requested reference material has been replaced in a client side browser" (See Vellandi Col. 6, lines 18-58).

As per claim 14, most of the limitations of this claim have been noted in the rejection of claim 11. Applicant's attention is directed to the rejection of claim 11 above. In addition, Vellandi discloses a requested reference material that is a text segment since the reference materials in this are electronic books (See Vellandi Abstract).

As per claim 15, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. Regarding the claimed feature of "determining if the requested reference material is made available on limited

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basis or on an unlimited basis” Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that he/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10).

As per claim 16, most of the limitations of this claim have been noted in the rejection of claim 15. Applicant’s attention is directed to the rejection of claim 15 above. In addition, Vellandi discloses the claimed feature of “determining whether a server has possession of a token corresponding to the requested reference materials” as a cookie that is transmitted to the user from the server when a username and password is valid (col. 6, lines 27-33). Notice that in Vellandi the server always maintains possession of the cookie and release it when a request is made by a subscriber.

As per claim 17, most of the limitations of this claim have been noted in the rejection of claim 15. Applicant’s attention is directed to the rejection of claim 15 above. In addition, as to the claimed feature of transmitting “a computer readable copy of the requested material to a requester’s computer” Vellandi achieved that since Vellandi’s method is being implemented in a network of computers (See Vellandi Figure 1).

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As per claim 18, most of the limitations of this claim have been noted in the rejection of claim 15. Applicant's attention is directed to the rejection of claim 15 above. In addition, Vellandi discloses the claimed feature of "receiving an indication when the requester has finished accessing the requested material" as a cookie which is returned to the server as an indication that the requester has finished accessing the requested material (See Vellandi Col. 1, line 64-Col. 2, line 5).

As per claim 19, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "passing possession of a token corresponding to the requested reference material from a server to the requester each time that on-line access to the requested material for the requester is provided if the requested material is made available on a limited basis; receiving an indication in the form of a return of the token corresponding to the requested reference material each time the requester has finished accessing the requested material (See Vellandi Col. 1, line 51-Col. 2, line 28).

As per claim 20-24, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. Regarding the claimed feature of --providing limited access and unlimited access collection of reference material-- Vellandi achieved these limitations by providing mechanism to allow a

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subscriber access to books that he/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10). As to the claimed feature of “allowing only a central authority to update the limited access collection of reference material” this can be achieved by the system administrator through the Internet Server Provider (See Vellandi Col. 5, lines 57-60).

It is noted however, Vellandi did allow users to update unlimited access collection of reference materials as recited in the instant claim 20. However, the Examiner takes official notice that allowing users to update a reference is well known in the art.

As per claim 25, most of the limitations of these claims have been noted in the rejection of claim 20. Applicant’s attention is directed to the rejection of claim 20 above. In addition, Vellandi discloses a user interface as I/O interface 18 and I/O interface 20 (See Vellandi figure 1).

As per claim 26, most of the limitations of this claim have been noted in the rejection of claim 20. Applicant’s attention is directed to the rejection of claim 20 above. Regarding the claimed feature of “determining if the requested reference material is made available on limited basis or on an unlimited basis” Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that he/she does not share with another subscriber, in this case

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access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10).

As per claim 27, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses an interface as I/O interface 18 and I/O interface 20 (See Vellandi figure 1). A "processor programmed" primarily incorporated in the computer network of figure 1. Regarding the claimed feature of --determining if the requested reference material is made available on limited basis or on an unlimited basis-- Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that he/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10).

As per claim 28, most of the limitations of this claim have been noted in the rejection of claim 27. Applicant's attention is directed to the rejection of claim 27 above. In addition, Vellandi discloses a requested reference material that is a text segment since the reference materials in this are electronic books (See Vellandi Abstract).

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As per claim 29, all the limitations of this claims have been noted in the rejection of claim 27. It is therefore rejected as set forth above.

As per claim 30, all the limitations of this claims have been noted in the rejection of claim 1. It is therefore rejected as set forth above.

As per claim 31, all the limitations of this claims have been noted in the rejection of claim 11. It is therefore rejected as set forth above.

As per claim 32, all the limitations of this claims have been noted in the rejection of claim 15. It is therefore rejected as set forth above.

As per claim 33, all the limitations of this claims have been noted in the rejection of claim 20. It is therefore rejected as set forth above.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and trademarks

Washington, D.C. 20231

or faxed to:

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(703) 305-9051, (for formal communications
intended for entry)

Or:

(703) 308-5357 (for informal of draft
communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington.
VA., Sixth Floor (Receptionist).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is (703) 305-4006. The examiner can normally be reached Monday through Friday from 9:30 A.M. to 6:00 P.M.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436. The Fax phone numbers for this

Group are: **After-final** **(703) 746-7238**

Official **(703) 746-7239**

Non-Official/Draft **(703) 746-7240**


FRANTZ COBY
PRIMARY EXAMINER

Technology Center 2171

February 7, 2003